



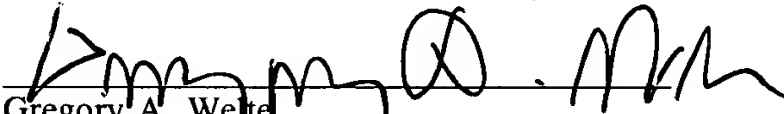
AF
Ifu

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Assignee's Docket No.: 9399.00)
Group Art Unit: 2176)
Serial No.: 09/704,066)
Examiner: Rachna Singh)
Filing Date: November 1, 2000)
Title: Defining a Process by a)
Plurality of Pages in a)
Mark-up Language)

CERTIFICATE OF MAILING

I certify that this document is addressed to Mail Stop AF, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, and will be deposited with the U.S. Postal Service, first class postage prepaid, on November 27, 2007.


Gregory A. Welte

REPLY BRIEF

Re: Pages 1 - 10 of Examiner's Answer ("Answer" Herein)

This section of the Answer contains

- 1) boilerplate and
 - 2) a restatement of the Final Office Action
- ("Final Action" herein).

No reply is required. The Brief addressed the Final Action.

General Comment on Answer

The Answer, page 10 et seq., attempts to rebut selected assertions made in the Brief, but not the remainder of the Brief.

09/704,066
Art Unit 2176
9399.00

The remaining discussion in the Brief is sufficient to overcome the rejections.

SUMMARY OF SELECTED POINTS OF THIS REPLY BRIEF

Point 1

The claims recite "objects" (eg, items used in computer software), such as

1) a "pass-through object,"

and

2) a "page embedded control object," (ie, a "control object" "embedded" in a "page," such as a web page).

To show item (1), the Answer purports to find an "object" in the reference, which "passes through" something else.

To show item (2), the Answer purports to find a command in the reference which is "embedded" in an HTML document.

Appellant points out that, even if the Answer be correct, it does not go far enough. The reason is that the claims state that the "objects" possess **stated properties**, which the Answer has not shown.

For example, the claims state that the "page embedded control object" (item (2) above) calls the "pass-through object" (item (1) above). The Answer has not shown that in the reference.

As another example, claim 1 recites:

09/704,066
Art Unit 2176
9399.00

said **passthrough object** interprets output information received from a **page embedded object** to generate a call to a contained object that in turn calls the desired operational object; and

said **passthrough object** receives event data from a called operational object and returns input data to said initiating **[page] embedded object** indicative of said returned event.

This inter-related operation of the "page embedded control object" (item (2) above) and the "pass-through object" (item (1) above) has not been shown in the reference.

Point 2

Claim 1 recites a **single** "pass-through object."

The Examiner purports to find the "pass-through object" in a command which Shima generates. That command is directed to a "target device," such as

- 1) a VCR,
 - 2) a video camera,
 - 3) a CD changer,
- etc. (Column 6, line 66 et seq.)

Thus, since **multiple** commands are generated in Shima, for **multiple** devices, the **single** "pass-through object," as claimed, is not present.

The Answer may be asserting that Shima only generates a **single**

09/704,066
Art Unit 2176
9399.00

command at any given time. However, that would appear to be incorrect. No reason appears why Shima's VCR and CD changer would not be operated at the same time. Further, such simultaneous operation would seem to be required, since Shima discusses a home theater system. (Column 1.)

Point 3

In an attempt to rebut the conclusion of Point 2, above, the Answer asserts that Shima **does not state** that generating multiple commands is Shima's only mode of operation.

That is, the Answer asserts that Shima **COULD** teach something else.

Appellant points out that a hypothetical possibility, namely, what Shima **could teach**, is not prior art. The rejection must be based on prior art.

Appellant states this another way. The Answer is asserting that the **absence of a teaching** in Shima acts to supply that (absent) teaching. That is simply false.

END SUMMARY

Re: Answer, Paragraph Bridging Pages 10 and 11

The paragraph of the Answer bridging pages 10 and 11 repeats language of the Final Office action, which language the Answer also sets forth on page 5, paragraph beginning with "in column 18

09/704,066
Art Unit 2176
9399.00

. . ."

This paragraph fails to rebut the arguments of the Brief, and the Brief is a sufficient response.

**Re: Answer, Page 11, First Full Paragraph
(Beginning with "In providing web surfing . . .")**

This paragraph, in essence, argues that, since Shima states that he can surf the Internet, a "browser" is necessarily present in Shima. This contention has been addressed by the Brief, for example, on page 28, section entitled "FLAW 6 - PROBLEM 2."

The basic problem is that, the mere presence of a "browser" in Shima does not show the **claimed browser**. For example, claim 1 states that the "browser" is "controlled by a controlling container object." It also states that "operational objects are contained within said container object."

A garden-variety "browser," which Shima is cited to show, does not possess these properties, nor the claimed relationship with a "container object."

**Re: Answer, Paragraph Bridging Pages 11 and 12
(Beginning with "Appellant further argues . . .")**

The Brief, page 45, section entitled "Point 3," explains that claim 1 recites **bi-directional passing**, which is **not symmetrical**.

This section of the Answer merely does three things.

ONE - It paraphrases Appellant's bi-

09/704,066
Art Unit 2176
9399.00

directional argument.

TWO - It paraphrases claim 1.

THREE - It then makes some assertions about Shima.

But the Answer does not rebut the Brief's explanations that

1) the claim recites **bi-directional, non-symmetrical, passing,** and

2) Shima does not show such "passing."

Specifically, the Answer's allegations as to the content of Shima, given at the top of page 12, utterly fail to show the bi-directional, non-symmetrical, "passing," as the Brief explains is found in claim 1.

Further, the Answer's content at the top of page 12 is a copy of the Final Action's assertions, which copy is also contained in the Answer, page 4, last paragraph (beginning with "the pass-through command . . ."). The Answer has added nothing to the Final Office Action, which the Brief rebutted.

Further still, Appellant points out that the Answer fails to interpret the claim language properly. Claim 1 recites a "pass-through object" **and also** sets forth properties of that "pass-through object."

The Answer merely finds something in Shima which supposedly "passes through" something else, and uses that thing to show the claimed "pass-through object."

09/704,066
Art Unit 2176
9399.00

That is insufficient. The "pass-through object" as claimed must be shown in the reference.

**Re: Answer, Page 12, First Full Paragraph
(Beginning with "Appellant argues that claim 1 . . .")**

As to the Answer's assertion that Shima shows the "single" pass-through object of the claim, Appellant here repeats a passage from the Brief:

Claim 1 recites a "single" "passthrough object." The Specification, page 12, line 22 et seq., explains that the **single** "passthrough object" keeps track of which web pages are active.

Under the PTO's interpretation of Shima, **multiple** entities having "pass-through functionality" are present. That is, Shima expressly states that multiple representations of control panels are generated, one for each of several different devices.

Thus, Shima is **directly contrary** to this recitation of claim 1.

(Brief, page 35.)

Further, the Answer's present assertion contradicts its own previous statements. As explained above, the Answer finds the claimed "pass-through object" in something in Shima which "passes through" something else.

In so doing, the Answer, page 4, section beginning "-The pass-through command . . .", states that "the pass-through command code

09/704,066
Art Unit 2176
9399.00

is communicated to the target device."

But Shima contains **multiple target devices**. As the Brief explains on page 22, Shima generates a representation of a control panel for each of

- 1) a VCR,
 - 2) a video camera,
 - 3) a CD changer,
- etc. (Column 6, line 66 et seq.)

Each of those devices (VCR, video camera, CD changer, etc.) is a "target device."

Consequently,

- the Answer states that "the pass-through command code is communicated to the **target device**,"
- Shima shows **multiple target devices**,
- THEREFORE, Shima shows **multiple** "pass-through command codes."

Since those "command codes" are used to show the claimed "pass-through object," the claimed **SINGLE** "pass-through object" is missing from Shima.

The Answer's present contention (in the first full paragraph on page 12) contradicts the Answer's previous contention.

Further still, as the Brief, page 34, section entitled "Point 3," explains, no "passthrough object" whatever, as claimed, is

09/704,066
Art Unit 2176
9399.00

found in Shima.

**Re: Answer, Paragraph Bridging Pages 12 and 13
(Beginning with "Appellant argues Shima does not . . .")**

Point 1

The Answer refers to three arguments of the Brief. Then, in the fourth sentence (beginning with "Additionally, Shima . . ."), the Answer repeats part of the Final Action, which is also repeated on page 5 (paragraph beginning with "In column 18 . . .").

The Brief addressed this part of the Final Action.

Point 2

As a matter of logic, the repeated part of the Final Action does not rebut the arguments of the Brief.

Those arguments of the Brief are

- No pages containing an "embedded control object" are found in Shima,
- That "embedded control object" does not call any "pass-through object" in Shima, and
- Shima fails to show the claimed visual icon.

The repeated section simply does not refute the Brief's assertions.

09/704,066
Art Unit 2176
9399.00

**Re: Answer, Page 13, Last Paragraph
(Beginning with "In providing web surfing . . .")**

Assume arguendo that Shima suggests use of a web browser.

The Answer then asserts that (1) Shima's web browser displays pages, and (2) the pages contain "embedded control objects."

Even if that be true, that is insufficient. As the Brief explains, beginning on page 24, the claims state that the "embedded control objects" have specific properties. Those properties have not been shown in Shima.

A similar comment applies to the claimed "pass-through objects." The Answer merely asserts that, in Shima, something "passes through" something else. But that fails to show the claimed properties of the claimed "pass-through object."

To repeat:

- showing an "object" in Shima which is "embedded" in something else does not show the "embedded control object" **as claimed;**
- showing something in Shima which "passes through" something else does not show the "pass-through object" **as claimed.**

In both cases, the claims recite properties of the "object" which have not been shown in Shima.

09/704,066
Art Unit 2176
9399.00

**Re: Answer, Page 14, First Paragraph
(Beginning with "With respect to claims 2 and 3 . . .")**

Point 1

This paragraph repeats part of the Final Action, which itself is repeated in the Answer, on page 6, first paragraph.

The term "self-service terminal" is a term-of-art, and refers to a "terminal" which interacts with a customer, and is located in a public place.

It is not merely a "terminal" which performs a "service." The Brief, page 50, section entitled "Claims 2 and 3" explains this.

Point 2

Appellant respectfully points out that one specific assertion of the Answer is ludicrous. That is the last sentence of the paragraph in question, which states that Shima's terminal can "include an ATM."

Shima shows a home-theater system. (Column 1.) People do not have ATMs in their homes.

The Answer is invoking the Doctrine of Inherency, because (1) Shima does not state that an ATM is present in his system, and (2) the Answer itself states that Shima's system "can include an ATM."

MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

09/704,066
Art Unit 2176
9399.00

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

The Answer fails to show the required "basis in fact and/or technical reasoning" as required by this MPEP section, to show that Shima shows an ATM in a home theater system.

Point 3

Appellant simply asks, "What connection would an ATM have with Shima's home theater system ?" The Examiner must answer this, in order to justify the assertion that an ATM is implied by Shima.

Appellant also asks, "What purpose would an ATM serve in a person's home ?" and "Why would that person thereby invite burglars to rob the ATM ?"

**Re: Answer, Page 14, Second Paragraph
(Beginning with "With respect to claims 12 - 20 . . .)**

Point 1

The Answer **directly contradicts the EXPRESS teachings of Shima.**

As explained above,

-- the Answer states that "the pass-through command code is communicated to the **target**

09/704,066
Art Unit 2176
9399.00

device, "

-- Shima shows **multiple target devices,**

-- THEREFORE, Shima shows **multiple** "pass-
through command codes."

Those "command codes" are used to show the claimed "pass-through objects." Consequently, according to the PTO, **multiple** "pass-through objects" are found in Shima.

Point 2

The Answer asserts that this conclusion "does not mean that a single passthrough object can¹ be created."

That is, the Answer is stating that (1) Shima shows one thing, but (2) he **could** show the opposite.

That is irrelevant. What Shima **could** show is **NOT prior art.**

And, again, the Doctrine of Inherency applies. Shima does not show what the PTO asserts. If the PTO wants to interpret Shima as showing what the PTO wants, then the PTO must show the "basis in fact and/or technical reasoning" as required by MPEP § 2112.

Point 3

The last sentence of the Answer's paragraph is irrelevant, and also not dispositive.

¹ Sic. This should probably be "cannot."

09/704,066
Art Unit 2176
9399.00

The Answer is arguing, in essence, that since Shima **does not** teach something, that therefore Shima teaches the opposite.

The lack of logic in this argument is apparent on its face.

The Answer is asserting that the lack of evidence is evidence itself.

**Re: Answer, Page 14, Third Paragraph
(Beginning with "Appellant further argues . . .)**

The Answer fails to consider the complete claim language.
Appellant repeats a passage from the Brief:

Claim 1 recites:

a plurality of pages are
defined in a mark-up language that
are selectively displayed and
executed **by a controlled browser.**

Appellant points out that the PTO relies
on Shima's implied browser of column 18, lines
34 - 37.

But claim 1 states that the "browser"
generates "control objects," which perform
specified functions. That has not been shown
in Shima.

(Brief, page 44.)

The claim does not recite pages "selectively displayed
. . . by a browser" as the Answer asserts.

The claim states "selectively displayed **and executed** by a
controlled browser."

09/704,066
Art Unit 2176
9399.00

Thus, even if the language cited by the Answer is, in fact, found in Shima, that language does not correspond to the claim.

**Re: Answer, Paragraph Bridging Pages 14 and 15
(Beginning with "Appellant argues claim 1 and 12 . . .")**

The Brief, beginning on page 55, addresses the Answer, and shows why Shima does not show claim 12.

**Re: Answer, Page 15, First Full Paragraph
(Beginning with "Appellant Argues . . . Claims 21 - 27 . . .")**

Point 1

The Brief, beginning on page 60, addresses the Answer.

Appellant points out that references are read as-a-whole. If Appellant finds something in a reference which contradicts the Examiner's position, then the Examiner must resolve the discrepancy.

The Answer's position that it can selectively cite parts of a reference, to the exclusion of other parts, is not supported by the MPEP. MPEP § 2141.02 states:

In determining the differences between the prior art and the claims, the question under 35 USC 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

MPEP § 2141.03, last paragraph, states:

09/704,066
Art Unit 2176
9399.00

Prior art must be considered in its entirety,
including disclosures that teach away from the
claims.

Point 2

This section of the Answer makes a generalized assertion that the Brief has repeatedly failed to explain why claim elements are not found in the references, as the Examiner asserts.

In essence, the Answer asserts that,

-- if a claim recites an "apple,"

and

-- if the Examiner cites a pineapple in a
reference as showing the claimed "apple,"

then

-- it is insufficient for the Appellant to
point out that an apple is not present in the
reference.

In response to this, Appellant points out that the issue is whether Appellant's statements in the Brief are correct. (Brief, page 59 et seq.)

The issue is not whether Appellant attempted to prove a negative, namely, why the claim elements are not shown in the reference.

09/704,066
Art Unit 2176
9399.00

Point 3

The initial burden of proof is on the Examiner. If the Examiner cites a reference as showing a claim element, and the reference clearly fails to do so, then it is sufficient for Appellant to point out the failure, without further explanation.

Point 4

Continuing Point 3, Appellant points out that 37 CFR § 1.104(c)(2) states:

. . . the Examiner must cite the best references at his . . . command.

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.

The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

This rule, in essence, states that, the claim elements in a reference must be identified, if not "apparent."

If Appellant states, in argument, that the claim elements are not found in the reference, then, under this rule, the Examiner must explain why Appellant is wrong.

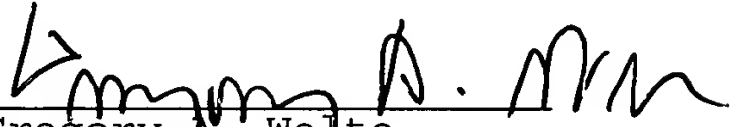
Again, the burden is on the Examiner. Appellant is not required to prove a negative.

09/704,066
Art Unit 2176
9399.00

CONCLUSION

Appellant requests that the Board overturn all rejections, and pass all claims to issue.

Respectfully submitted,


Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 4W
Dayton, OH 45479
November 27, 2007
(937) 445 - 4956
WELTE DIRECT: (765) 296 - 4699